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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,566	12/21/2001	Eric J. Horvitz	MS177851.1	4018

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EXAMINER

BOUTAH, ALINA A

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/036,566

Applicant(s)

HORVITZ ET AL.

Examiner

Alina N. Boutah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 18, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37-39, 41, 42, 45-47 and 69 is/are pending in the application.
- 4a) Of the above claim(s) 69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 18, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37-39, 41, 42 and 45-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/5/02, 5/27/02, 9/15/03</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of group I in the reply filed on September 9, 2005 is acknowledged. However, this is not found persuasive because Applicant fails to provide the ground of traversal. The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

The information disclosure statement filed March 13, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

The disclosure is objected to because of the following informalities: the blank spaces under the cross-references need to be filled. Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 11/047,068. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the copending application (11/047,068) discloses every limitation claimed by the present invention except it further defines the communication group manager as comprising: a communication group establisher that establishes the group of communicating parties; and a communication group modifier that dynamically modifies the group of communicating parties.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 18, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37-39, 41, 42, 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0156879 submitted by Delany et al. (hereinafter referred to as Delany) in view of US 2003/0033421 by Haeri et al. (hereinafter Haeri).

Regarding claim 1, Delany teaches a computer-based system that facilitates optimizing utility of a communication, the system comprising:

a communication group manager that manages a group of communication a parties to facilitate optimizing the utility of the communication along a communication channel identified by the identifier [figures 3, 5, 8-10, 26, abstract]; and

a group wise communication coordinator that coordinates communication between a subset of the managed group of communicating parties to facilitate maximizing the utility of the communication [figures 3, 5, 8-10, abstract].

However, although Delany discloses communication along a communication channel [0360], he fails to explicitly teach an identifier that identifies one or more communication channel that facilitates maximizing the utility of the communication. Haeri teaches identifying one or more communication channel that facilitates maximizing the utility of the communication (figures 4, 7 and 9; table 1; 0016). At the time the invention was made, one of ordinary skill in the art would have been motivated to identify a communication channel that facilitates maximizing the utility of the communication in order to allocate bandwidth to certain group of communication parties, thus maximizing the system's efficiency.

Regarding claim 18, Delany teaches the system of claim 1, where the communication occurs between one or more contactors and one or more contactees and where the identifier comprises:

a processor [0016];

a preference resolver that analyzes a contactee preference data and a contactor preference data and produces a resolved preference data [0109];

a context analyzer that analyzes a contactee context data and a contactor context data and produces an analyzed context data [table 3]; and

a communication establisher that establishes a communication between the contactor and the contactee based, at least in part on the resolved preference data that analyzed context data communicating party selection data and the communication channel data [360].

However, Delany fails to explicitly teach a channel analyzer that analyzes one or more communication channels between a contactor and a contactee and produces a communication channel data. Haeri teaches a channel analyzer that analyzes one or more communication channels between a contactor and a contactee and produces a communication channel data (figures 4, 7 and 9; table 1; 0016). At the time the invention was made, one of ordinary skill in the art would have been motivated to employ a channel analyzer in order to allocate bandwidth to certain group of communication parties, thus maximizing the system's efficiency.

Regarding claim 19, Delany teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communication parties are concurrently engaged in a related activity, or are likely to become concurrently engaged in a related activity [112].

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Regarding claim 21, Delany teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communicating parties are concurrently processing one or more related documents, or are likely to concurrently process one or more related documents [112].

Regarding claim 23, Delany teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communicating parties are concurrently processing one or more related documents, or are likely to concurrently process one or more related documents [112].

Regarding claim 25, Delany teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communication parties are concurrently viewing one or more related documents, or are likely to concurrently view one or more related documents (figure 12).

Regarding claim 27, Delany teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communicating parties are concurrently engaged in a shared project, or are likely to become concurrently engaged in a shared project [211].

Regarding claim 29, Delany teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communicating parties are scheduled to communicate

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within a predefined period of time, or have communicated within a pre-determined period of time [308].

Regarding claim 31, Haeri teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communicating parties are scheduled to meet within a pre-defined period of time, or have met within a pre-defined period of time [039].

Regarding claim 33, Delany teaches the system of claim 1, the utility optimization based at least in part upon whether a communicating party has engaged in one or more pre-defined activities of interest within a pre-defined period of time, or is likely to engage in one or more pre-defined activities of interest within a pre-defined period of time [114].

Regarding claim 37, Delany teaches the system of claim 1, the utility optimization based at least in part upon the degree to which a communicating party is trusted by one or more other communicating parties [485].

Regarding claim 38, although Delany and Haeri fail to disclose the computation of an expected utility for the communication using the claimed formula, Applicant has admitted that this was an example of a Bayesian network probabilistic model (see specification page 8, line 25 to page 9, line 19), therefore this feature is known in the art.



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Regarding claim 39, Delany teaches the system of claim 1, where the utility of communication is based at least one of a cost and a benefit of the communication to at least one of a contactor and a contactee; wherein at least one of the cost and the benefit of the communication is related to one or more preferences of at least one of the contactor and the contactee [403].

Regarding claim 41, Delany teaches the system of claim 39, where a utility function employed to compute the utility of the communication is a combination of functions that separately consider at least one of the cost and the benefit of the communication to at least one of the contactor and contactee [403].

Regarding claim 42, Delany teaches the system of claim 39, where a utility function employed to compute the utility of the communication is a multi-linear combination of one or more weighted terms associated with at least one of the contactor and contactee (figure 26).

Regarding claim 45, the combination of Delany and Haeri teaches a computer useable medium having embodied thereon computer executable components of the system of claim 1 (see the cited areas above).

Regarding claim 46, Delany teaches the system of claim 1 where the group wise communication coordinator comprises: a group wise communication assembler that assembles the group communicating parties, and a group wise communication scheduler that schedules a

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time for the group communication that maximizes the utility of the communication [figures 3, 5, 8-10, abstract].

Regarding claim 47, the system of claim 46, where the group wise communication assembler identifies one or more group member classification required for the group communication; identifies a minimal number of communicating parties from each of the one or more group member classification required for the group communication, and verifies that at least the minimal number of communicating parties from each of the one or more group member classifications are available for the group communication [abstract, 0011, 0016, 0039].

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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